REMARKS

Claims 1-5 and 18-32 are pending in the application. Claims 1-5 and 18-32 stand rejected. Claim 3 has been amended. No claims have been cancelled. Claims 1-5 and 18-32 remain pending. For at least the reasons provided below, Applicant believes the application is in condition for allowance and respectfully requests reconsideration by the Examiner.

Rejections under 35 U.S.C. § 112

Claims 3, 4, and 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner states his belief that in claim 3, "film" is synonymous with "plastic film." Final Office Action, p. 2, ¶ 2. Without acquiescence to the Examiner's interpretation of the term "film," Claim 3 has been amended to require either a "polyester or polypropylene plastic film." The rejections of claims 3 and 4 under 35 U.S.C. § 112 are therefore believed to be overcome.

With respect to claim 24, the Examiner states that the term "layer" lacks antecedent basis in the amended claim 1. Applicant respectfully disagrees. Claim 1, line 4 recites "a pre-textured, ready-to-paint ***layer*** applied to the upper surface" (emphasis added). Claim 1 therefore provides sufficient antecedent basis for the term "layer" found in claim 24.

Claims 18-23 and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the Examiner states that, "in claim 18 the deletion of the 'applied layer to the upper surface' is believed to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." Final Office Action, p. 2, ¶ 3. Again, however, Applicant respectfully disagrees.

Applicant's specification expressly discloses that the ready-to-paint upper surface can be the upper surface of the plastic film itself. *See, e.g.*, FIG. 1; Specification, p. 4, lines 22-23, p. 5, lines 4-6. Specifically, identifying the upper surface 12A of the body (*e.g.*, the film) 12 shown in FIG. 1, the specification explains that the "first, upper surface 12A is directly paintable." p. 4, lines 22-23. The specification further explains that "[t]he upper surface 12A can also be pre-textured ... by applying a texture coat later 15" (p. 4, lines 27-28) or that "[a] wall patch 10 having a smooth upper surface 12A can also be provided for use in repairing walls that have a non-textured wall surface" (p. 5, lines 4-6). The specification therefore clearly teaches embodiments in which a separate pre-textured layer is applied to the upper surface, as well as embodiments in which the smooth, upper surface of the body itself can provide the directly paintable upper surface. The Examiner is therefore incorrect in his

conclusion that the specification does not "teach embodiments which comprise only a central flexible sheet having adhesive on the lower surface and being ready to paint on the upper surface of the flexible sheet." Final Office Action, p. 2, ¶ 3.

For each of the foregoing reasons, the Examiner's rejections under 35 U.S.C. § 112 are believed to be overcome.

Rejections under 35 U.S.C. § 103(a)

Claims 1-5 and 18-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens, et al, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for claims 1-5, 20, 31, and 32, for claims 5 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada. The Examiner acknowledged that the Declarations of Jerry E. Brower and Gale Bruns (and accompanying Exhibits) might present a strong case for both commercial success and long felt need, but the Examiner would not give the Declarations any weight, however, because they were not dated.

Without acquiescence to the Examiner's conclusions as to whether a prima facie case of obviousness exists, to the Examiner's position on the state of ordinary skill in the art, or to his conclusion that the undated declarations are not entitled to any weight, Applicant submits herewith the dated Declarations of both Jerry E. Brower and Gale Bruns. The Exhibits remain as previously presented and are not being resubmitted herewith. As the Examiner recognized, these declarations and the accompanying Exhibits provide strong evidence of non-obviousness and the Examiner's rejections under 35 U.S.C. § 103(a) are therefore believed to be overcome.

In response to the Examiner's inquiry regarding the relationship between the present application and copending U.S. Patent Application Serial No. 10/728,647, Applicant provides the following clarification. Mr. Swanson is the sole inventor of the present application. Mr. Brower, however, is an inventor with respect to the new subject matter added in the copending U.S. Patent Application Serial No. 10/728,647.

Claims 1-5 and 24-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman, Sr. '949, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for all of the rejected claims, and for claim 5 in view of the FASSON publication.

Again, without acquiescence to the Examiner's conclusions as to whether a prima facie case of obviousness exists, to the Examiner's position on the state of ordinary skill in the art, or to his conclusions that the undated declarations are not entitled to any weight,

Applicant's submission herewith of the dated Declarations of both Jerry E. Brower and Gale Bruns provide strong evidence of non-obviousness and the Examiner's rejections under 35 U.S.C. § 103(a) are therefore believed to be overcome.

Conclusion

For at least the foregoing reasons, reconsideration and allowance of claims 1-5 and 18-32 in the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Craig R. Rogers
Reg. No. 43,888

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
Customer No. 20575